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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,258

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EXAMINER

LIVERSEDGE, JENNIFER L

ART UNIT

PAPER NUMBER

3692

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/917,258	<b>Applicant(s)</b> MAKINO ET AL.	
	<b>Examiner</b> Jennifer Liversedge	<b>Art Unit</b> 3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-7,9-24,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7,9-24,32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/917,258 filed on November 17, 2006.

The amendment contains original claims: 4-5, 7 and 9-12.

The amendment contains previously presented claims: 3, 6, 13-24 and 33.

The amendment contains amended claims: 32.

Claims 1-2, 8, 25-31 and 34-35 have been canceled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-6, 14-17, 22-24 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,973,442 B1 to Drummond et al. (further referred

to as Drummond), and further in view of U.S. Patent No. 6,508,398 B1 to Estes (further referred to as Estes).

Regarding claim 32, Drummond discloses in a bank processing network (column 6, lines 25-41) having a plurality of automated teller machines (ATMs) (column 6, lines 25-41) and an information processing system (column 6, lines 25-67), wherein the information processing system comprises a central marketing customer information file (MCIF) server (column 5, lines 5-7; column 9, lines 1-40; column 10, lines 25-43; column 16, lines 9-67; column 18, line 62 – column 19, line 67), a method for providing customer service information to a customer conducting a transaction at one of the ATMs (column 16, lines 4-67), the method comprising:

Storing customer service information at the MCIF server (column 15, line 65 – column 16, line 3; column 16, lines 22-28; column 17, lines 1-4), the customer service information including customer attribute information and associated customer offer information, the customer offer information relating to customer specific marketing to a customer based on customer attribute information of that customer (column 16, lines 22-32);

In advance of a customer transaction, downloading at least parts of the customer service information from the MCIF server to the ATM, and arranging the customer service information at the ATM (column 10, line 64 – column 11, line 42; column 18, line 62 – column 19, line 67);

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wherein the bank processing network further comprises a central accounting system for storing transaction data for conducting transactions at the ATM, the central accounting system being separate from the central MCIF server (column 10, lines 25-43; column 17, lines 30-40; Figure 3), and wherein the bank branch office is located remotely from the central accounting system and central MCIF server (Figure 1; column 4, lines 53-58); and

wherein the network is operated by one bank with a plurality of remote bank branch offices, wherein the central accounting system and the central MCIF server are located at a central location of the bank (Figures 1 and 3; column 4, lines 53-58; column 10, lines 25-43; column 11, lines 8-42; column 17, lines 30-40).

Drummond does not disclose:

at least one integrated ATM monitoring apparatus, wherein the ATM monitoring apparatus and the ATMs are in two-way communication with each other and are located at a branch office of the bank,

Transmitting customer specific information from an ATM to the ATM monitoring apparatus in response to a customer conducting a transaction at the terminal;

providing selected customer offer information from the ATM monitoring apparatus to the ATM in response to the customer specific information; and

wherein the ATM monitoring apparatus and the ATMs are located at one of the branch offices of the bank.

However, Estes discloses:

at least one integrated ATM monitoring apparatus, wherein the ATM monitoring apparatus and the ATMs are in two-way communication with each other and are located at a branch office of the bank (Figure 1; columns 1-3),

Transmitting customer specific information from an ATM to the ATM monitoring apparatus in response to a customer conducting a transaction at the terminal (columns 1-3);

providing selected customer offer information from the ATM monitoring apparatus to the ATM in response to the customer specific information (column 2, line 59 – column 3, line 4); and

wherein the ATM monitoring apparatus and the ATMs are located at one of the branch offices of the bank (Figure 1, columns 1-3).

It would be obvious to one of ordinary skill in the art to combine the use of a local ATM controlling promotions as disclosed by Estes with the ATM service as disclosed by Drummond. The motivation would be that the local ATM is in direct contact with the customer and can provide an advertisement or promotion based on the transaction information, using local controls, while still maintaining a database of stored information at a central server.

Regarding claim 33, Drummond discloses the method further comprising:

Storing a plurality of screen displays in advance at the ATM, each screen display relating to a different customer offer information (column 18, line 62 – column 19, line 67); and

Displaying one of the screen displays at the ATM in response to the selected customer offer information being provided from the ATM monitoring apparatus to the ATM (column 7, lines 25-48; column 11, lines 16-42; column 16, line 4 – column 17, line 5; column 17, line 51 – column 18, line 9; column 18, line 62 – column 19, line 67).

Regarding claim 3, Drummond discloses the method wherein the customer attribute information comprises information identifying either one or both of (a) particular personal attributes of the customer and (b) attributes of an account maintained for the customer (column 13, lines 13-34; column 16, lines 1-3 and 22-28).

Regarding claim 4, Drummond discloses wherein the customer attribute information further comprises data identifying the bank account of the customer (column 5, lines 5-19).

Regarding claim 5, Drummond discloses the method wherein the customer attribute information further comprises the address of the customer (column 12, lines 53-56; column 13, lines 24-30).

Regarding claim 6, Drummond discloses the method wherein the customer attribute information further comprises data relating to prior transactions conducted by the customer (column 16, lines 25-29; column 23, lines 13-18).

Regarding claim 14, Drummond discloses the method wherein the customer offer information relates to information for implementing a customer specific service to a plurality of customers having related customer attribute information (column 17, line 65-column 18, line 1).

Regarding claim 15, Drummond discloses the method wherein the terminal dispenses a card to the customer and wherein the customer offer information relates to display information to be printed on the card by the terminal (column 1, lines 39-42). Drummond discloses coupons, tickets, etc. all of which could be "cards" which is a relative term and will be interpreted to include items as disclosed by Drummond.

Regarding claim 16, Drummond discloses the method wherein the customer offer information relates to display information of potential interest to a plurality of customers having related customer attribute information, said display information comprising promotion display information relating to a promotional event of potential interest to the customers (column 17, line 65-column 18, line 1).

Regarding claim 17, Drummond discloses the method wherein the display information further comprises administrator display information relating to instructions for directing the customers to a human administrator for further action in connection with the promotional event (column 16, lines 15-67).



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Regarding claim 22, Drummond discloses the method wherein the customer specific information transmitted from the ATM comprises data identifying the customer (column 12, line 37 – column 13, line 30; column 14, lines 20-27).

Regarding claim 23, Drummond discloses the method wherein the customer specific information transmitted from the ATM further comprises data identifying the type of transaction being conducted by the customer (column 9, lines 47-52; column 13, line 60 – column 14, line 5; column 17, lines 12-25).

Regarding claim 24, Drummond discloses the method wherein the customer specific information transmitted from the ATM further comprises data identifying an account of the customer (column 12, line 37 – column 13; column 16, lines 22-33; column 17, lines 6-40).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond and Estes as applied to claim 3 above, and further in view of "Citibank Unveils New Automatic Teller Machine Technology to Aid Individuals with Disabilities" by S. Weeks, Sept. 30, 1992 (further referred to as Weeks).

Neither Drummond nor Estes disclose wherein the customer attribute information further comprises data identifying whether the customer is sight-impaired and wherein the customer offer information operates the terminal so as to increase the size of the transaction information displayed on the terminal.

Drummond does disclose storing customer attribute information wherein examples if information stored include gender and customer preferences (column 16, lines 22-32), the use of HTML documents with tags assigned to control such features as fonts and layouts, such that the tags tell the browser how to display the information (page 2, lines 50-63), and wherein user information is stored and wherein users can establish preferences based on their stored information and wherein tags are used to display items on the screen according to those tags. Examiner takes Official Notice that the customer preference storing and use of HTML tags for feature and display control is old and well known. It would have been obvious to one of ordinary skill in the art at the time of invention that tags could be used to indicate printing larger font for those customers who are visually impaired, the motivation being to enable all customer s access to the ATM in a manner in which they could make use of the machine.

Further, Weeks discloses ATM technology to facilitate the accessibility of such individuals as visually impaired through the use of a large font size (page 2, lines 5-7 and lines 19-21).

It would be obvious to one of ordinary skill in the art to combine the use of large font size for conducting ATM transactions by the visually impaired as disclosed by Weeks with the ATM system as disclosed by Drummond and Estes. The motivation would be to provide ATM services for all individuals using existing technology, to do so.

Claim 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond and Estes as applied to claim 3 above, and further in view of

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"Neglected Shoppers Rejoice: Customer Service is Returning" by B. Aarsteinsen, Nov. 9, 1990 (further referred to as Aarsteinsen).

Regarding claim 9, neither Drummond nor Estes disclose the method wherein the customer attribute information comprises data identifying the customer as having special customer status. However, Aarsteinsen discloses the method wherein the customer attribute information comprises data identifying the customer as having special customer status (page 2, lines 49-52). It would be obvious to one of ordinary skill in the art to combine using the label of special customer as disclosed by Aarsteinsen with the ATM promotional and communication services as disclosed by Drummond and Estes. The motivation would be to create a label for the customers which Drummond segments/individualizes when their profile indicates they are a special customer and deserving of attention and focus.

Regarding claim 10, neither Drummond nor Estes disclose the method wherein the customer offer information comprises data causing the information processing system to notify a human administrator of the special customer status. However, Aarsteinsen discloses the method wherein the customer offer information comprises data causing the information processing system to notify a human administrator of the special customer status (page 2, lines 14-19). It would be obvious to one of ordinary skill in the art to combine notifying a human administrator regarding a special customer as disclosed by Aarsteinsen with the ATM promotional and communication services as

disclosed by Drummond and Estes. The motivation would be to be sure that special customers were given the highest level of service available and to have a positive experience during their transaction.

Regarding claim 11, neither Drummond nor Estes disclose the method wherein the customer attribute information comprises data identifying the customer as having preferred customer status. However, Aarsteinsen discloses the method wherein the customer attribute information comprises data identifying the customer as having preferred customer status (page 2, lines 49-52). It would be obvious to one of ordinary skill in the art to combine using the label of preferred customer as disclosed by Aarsteinsen with the ATM promotional and communication services as disclosed by Drummond and Estes. The motivation would be to create a label for the customers which Drummond segments when their profile indicates they are a preferred customer. The use of special or preferred customer designation is used in various applications in industry such as frequent flier airline awards programs, frequent guest hotel awards programs, frequent diner award programs is well known. In addition to programs related to frequency of interaction, guests of special status are identified based on prestige, title (President, CEO, etc.), level of savings accounts such as high-yield account holders, large-scale investors, etc. These individuals are often addressed by the more senior management, provided with special services, special allowances made, etc. For example, when a frequent flier checks in, the attribute information related to their account immediately identifies that traveler as a frequent flier and special boarding

and sometimes seat upgrades are offered based on that data. They are both a special customer, and a customer with preferred status.

Regarding claim 13, Drummond discloses the method wherein the customer offer information relates to display information to be displayed at the terminal and directing the customer to a human administrator (column 16, lines 47-55).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond, Estes and Aarsteinsen as applied to claim 9 above, and further in view of "Freddie Mac is Avoiding Bad Loans" by P. Reeves, Nov. 23, 1997 (further referred to as Reeves). Neither Drummond, Estes nor Aarsteinsen disclose the method wherein the special customer status is a poor credit status. However, Reeves discloses the method wherein the special customer status is a poor credit status (page 1, lines 9-14). It would be obvious to one of ordinary skill in the art to combine the label of poor credit as disclosed by Reeves with the ATM promotional and communication services as disclosed by Drummond, Estes and Aarsteinsen. The motivation would be to create a label for the customers which Drummond and Aarsteinsen segment/individualize when their profile indicates they are a special customer and deserving of attention and focus such that special attention is noted regarding their poor credit.

Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond and Estes as applied to claim 17 above, and further in view of "Tanger

Shoppers Score Big Outlet Savings During Super Bowl Scratch and Win Event" on PR Newswire, Dec, 1999 (further referred to as PR Newswire).

Regarding claim 18, neither Drummond nor Estes disclose the method wherein the promotion display information is printed on a game card dispensed at the terminal, the game card separately having portions to be rubbed away to reveal information relating to game awards.

However, PR Newswire discloses promotion display information printed on a game card dispensed at the terminal, the game card separately having portions to be rubbed away to reveal information relating to game awards (page 1, lines 11-14). It would be obvious to one of ordinary skill in the art to combine the distribution of game cards as disclosed by PR Newswire with the ATM dispensing mechanism as disclosed by Drummond and Estes. The motivation would be that in addition to vouchers and receipts and cash and tickets, etc. distributed, game cards would be distributed as an incentive to use the machine, or to build loyalty to the sponsoring institution.

Regarding claim 19, Drummond discloses the method wherein the customer offer information further relates to transaction display information on one or more transactions that may be selected by the customers and then conducted at the ATM (column 3, lines 20-25 and lines 48-51; column 16, lines 40-55; column 17, lines 12-15).

Regarding claim 20, Drummond discloses the method wherein the transaction display information displays information concerning standard transactions that are applicable to all customers who may use the ATM, and such transaction display information is displayed when neither of the promotion display information and the administrator display information is transmitted by the information processing system to the ATM (column 3, lines 20-25; column 10, line 64 – column 11, line 8; column 21, lines 61-67).

Regarding claim 21, Drummond discloses the method wherein the transaction display information is displayed when the promotion display information and the administrator display information is not displayed to the customer within a predetermined period of time after initiating a transaction at the ATM (column 14, lines 48-60; column 17, line 51 – column 18, line 10).

### ***Response to Arguments***

Applicant's arguments with respect to claims 3-7, 9-24 and 32-33 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

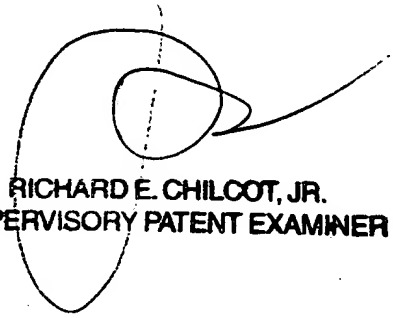
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at 571-272-6777. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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**RICHARD E. CHILCOT, JR.**  
**SUPERVISORY PATENT EXAMINER**